

## REMARKS

Claims 1-20, 24 and 25 have been cancelled without prejudice, and claims 41-59 have been added. No new matter has been added by virtue of the amendments. For support for the new claims appears e.g. at page 6, lines 10-19; page 7, lines 11-24; and the original claims of the application.

Claims 1-3, 11-12, 17-20 and 24-25 were rejected under 35 U.S.C. 102 over Nozaki et al. (U.S. Patent 6013416).

Claims 1-6, 10, 12-20 and 24-25 were rejected under 35 U.S.C. 102 over Jung et al. (U.S. Patent 6,132,926).

Claims 7-9 were rejected under 35 U.S.C. 103 over Nozaki et al. (U.S. Patent 6,013,416) in view of Barclay et al. (U.S. Patent 6,306,554).

Claims 7-9 were rejected under 35 U.S.C. 103 over Jung et al. (U.S. Patent 6,132,926) in view of Barclay et al. (U.S. Patent 6,306,554).

For the sake of brevity, the several rejections are addressed in combination. Each of the rejections is traversed.

All the pending claims call for a photoresist comprising a photoactive component and a polymer comprising a lactone moiety provided by polymerization of a monomer having a ring oxygen adjacent to a vinyl group.

The primary citations of Nozaki et al. and Jung et al. do not disclose or otherwise suggest such photoresist compositions, including the polymer lactone moiety as Applicants disclose and claim.

Nozaki et al. and Jung et al. were cited for a certain polymer carbonate group. The pending claims do not recite carbonate groups.

Accordingly, the rejections should be withdrawn. See, for instance, *In re Marshall*, 198 USPQ at 346 ("[r]ejections under 35 U.S.C. 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art."). See also Section 2143.03 of the Manual of Patent Examining Procedure ("To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.").

It is believed the application is in condition for immediate allowance, which action is earnestly solicited.

Respectfully submitted,



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